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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/141,496	10/22/1993	MARCUS F. BOEHM	203268	7787
20985	7590	06/29/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				DESAI, RITA J
		ART UNIT		PAPER NUMBER
		1625		

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/141,496	BOEHM ET AL.
	<b>Examiner</b> Rita J. Desai	<b>Art Unit</b> 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 4/17/2006.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 71,74,75 and 79-81 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 71, 74, 75, 79-81 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

Claims 71, 74, 75, 79-81 are pending. Claims 70, 72, 73 and 76-78 are cancelled.

Claims 71, 74 and 75 are amended..

The rejection of claim 70 under 35 U.S.C. 101 double patenting has been withdrawn because applicants have cancelled the claim.

The rejection of claims 71-81 under obvious type double patenting over the claims 1, 3, 29-41 of US 6310074 has also been withdrawn as applicants have gone claim by claim and identified the difference. Applicants have also cancelled the R1 and R" forming a cyclo ring.

The rejection of claim 78 under 102(g) and possibly 102 (f) over 08/141,296 has also been withdrawn because applicants have cancelled the claim.

The rejection of claims 71-81 under 35 U.S.C. 102(e) over US 5466861 Dawson et al has also been withdrawn because applicants have cancelled the R1 and R" forming a ring which did not get the priority date.

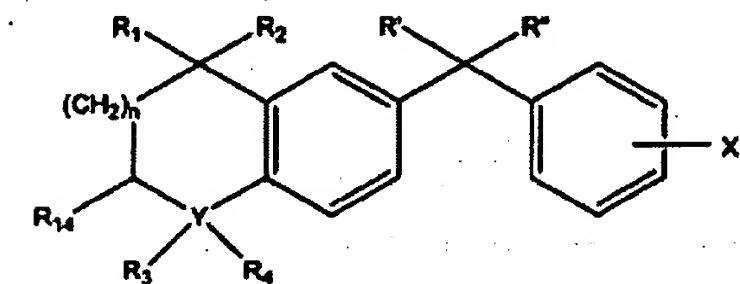
### **New Grounds of Rejection**

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

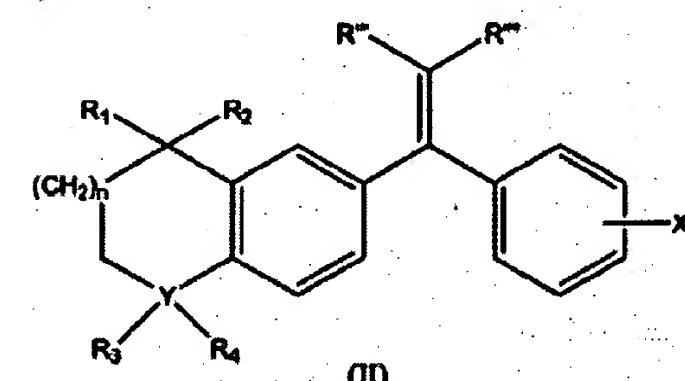
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 71, 74, 75, 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maignan et al. US 4833240. Applicants claims are drawn to compounds of the formula



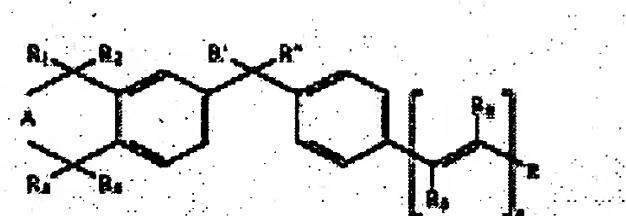
(I)

OR



(II)

Determination of the scope and content of the prior art (MPEP §2141.01)



The reference teaches the compounds of the formula

Wherein n can be a zero .

R' and R'' can be a methano, or each can be a hydrogen.

See the step 3 product compound 3, 4 in columns 5 and 6 or compound as given in column 11 and 12.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds described in the US patent are very similar to those of the applicants.

Generically they read on the applicants compound when n is 0 . R amongst a few options can be a -COOH group R1-R4 and R14 can be either a hydrogen or a lower alkyl group. The reference

also has the same options. The compound shown in column 12 and 13 has a methono group and applicants compounds have to have the R<sup>22</sup> to be a hydrogen or alkyl and R<sup>23</sup> to be an alkyl.

All the compounds taught in applicants specification which have a methano group have R<sup>22</sup> and R<sup>23</sup> to be a hydrogen. Thus limiting it to R<sup>22</sup> being an alkyl would be new matter and modifying a hydrogen to an alkyl group would also be a *prima facie* obvious modification.

Finding of *prima facie* obviousness--rational and motivation (MPEP §2142-2413)

Thus since all the compounds disclose the methano group, replacing a hydrogen with an alkyl group would be *prima facie* obvious, because it is well known in the art that changing a Hydrogen with a methyl is not unobvious unless there is a showing of unexpected results.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 71, 74, 75, 79-81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have limited the R<sup>22</sup> to be hydrogen and an alkyl and R<sup>23</sup> to be an alkyl group in their amendment filed 4/21/2003 and 6/11/2003.

The specification have compounds only drawn to R<sup>22</sup> and R<sup>23</sup> to be only hydrogen. See all the examples as given on pages 13 and 14. See last compounds on page 13.

Thus introduction of the limitation would constitute new matter.

***Conclusion***

Claims 71, 74, 75, 79-81 are not found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai  
Primary Examiner  
Art Unit 1625

R.D.  
June 26, 2006

*Rita J. Desai*  
6/26/06